

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Gopalan** §
§ Group Art Unit: **3691**
Serial No.: **09/888,470** §
§ Examiner: **Akintola, Olabode**
Filed: **June 25, 2001** §
§ Confirmation No.: **3831**
For: **Apparatus and Method for** §
Providing Dual Number Access §
Electronic Wallet §

35525

PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on September 5, 2008.

A fee of \$510.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0447. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0447. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation of Armonk, New York.

RELATED APPEALS AND INTERFERENCES

This appeal has no related proceedings or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

The claims in the application are: 17

B. STATUS OF ALL THE CLAIMS IN APPLICATION

Claims canceled: 1-16

Claims withdrawn from consideration but not canceled: None

Claims pending: 17

Claims allowed: None

Claims rejected: 17

Claims objected to: None

C. CLAIMS ON APPEAL

The claims on appeal are: 17

STATUS OF AMENDMENTS

No amendment after final rejection was filed for this case. The claims stand as written in the Amendment filed April 25, 2008.

SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the separately argued claims involved in the Appeal Brief as required by 37 C.F.R. § 41.37(c)(1)(v). The features are identified by corresponding references to the specification and drawings where applicable. It should be noted that the citations to passages in the specification and drawings for each feature do not imply that the limitations from the specification and drawings should be read into the corresponding claim element. Rather, this summary is provided for the convenience of the Board.

A. CLAIM 17 - INDEPENDENT

The subject matter of claim 17 is directed to a method of completing a financial transaction between a user having a payment account and a merchant having a merchant account, the method comprising:

- a) the user logging on to a centralized personal data base (FIG. 4, element 400; Specification 8:16-9:12) using a basic number (Specification 8:16-10:3) and a primary number (Specification 8:16-10:10), wherein the basic number is accessible by the user but not by the merchant (Specification 9:13-10:3);
- b) the user creating an electronic wallet in the centralized personal data base by inputting a payment account number of the user's payment account to associate with the electronic wallet (FIG. 5, elements 508, 511-512, 514, 516, 518, and 520; Specification 10:14-11:7), a payment limit of the electronic wallet (FIG. 5, element 532; Specification 11:17-18 and 2:6-7), and an expiration date of the electronic wallet (FIG. 5, element 528; Specification 11:13-16 and 2:7-8);
- c) responsive to the user creating the electronic wallet, the centralized personal data base generating a wallet number associated with the electronic wallet (FIG. 5, element 540; Specification 10:14-12:6 and 12:2-3);
- d) the user making a purchase from the merchant on a purchase date by sending the primary number and the wallet number to the merchant (FIG. 6, element 620; Specification 12:8-9), wherein the purchase has a price;
- e) the merchant sending the primary number and the wallet number to the centralized personal data base (FIG. 6, element 630; Specification 12:9-10); and

f) the centralized personal data base determining whether the purchase is authorized (FIG. element 640; Specification 12:15-16) by determining whether the purchase price exceeds the payment limit of the electronic wallet and whether the purchase date is after the expiration date (Specification 12:10-11), wherein the purchase is authorized when the purchase price does not exceed the payment limit and the purchase date is not after the expiration date (Specification 12:7-13:2 and Abstract);

g) responsive to determining that the purchase is authorized, the centralized personal data base debiting the user's payment account for the purchase price and crediting the merchant account (Specification Abstract and 2:8-10).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds of rejection to review on appeal are as follows:

A. GROUND OF REJECTION 1

Whether claim 17 was properly rejected under 35 U.S.C. 103(a) over U.S. Patent Application Publication No. 2001/0034725 (herein Park) in view of U.S. Patent Application Publication No. 2001/0034720 (herein Armes).

B. GROUND OF REJECTION 2

Whether claim 17 was properly rejected under 35 U.S.C. 103(a) over U.S. Patent Application Publication No. 2001/0034720 (herein Armes) in view of U.S. Patent No. 6,607,530 (herein Shub).

ARGUMENT

A. GROUND OF REJECTION 1 (Claim 17)

Claim 17 was rejected under 35 U.S.C. 103(a) over U.S. Patent Application Publication No. 2001/0034725 (herein Park) in view of U.S. Patent Application Publication No. 2001/0034720 (herein Armes). Final Office Action pp. 2-4.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

1. *Claim 17*

Claim 1 recites “responsive to the user creating the electronic wallet, the centralized personal data base generating a wallet number associated with the electronic wallet.” The Examiner alleges Park teaches these limitations citing to Park [0022]-[0023]. Final Office Action p.3.

The claim’s “wallet number” is outside the scope of Park at least because Park is silent to a “wallet number.” While Park’s system creates an electronic wallet (Park [0022]), Park is silent

to a “wallet number” generated and associated with its electronic wallet in response to the electronic wallet’s creation.

Furthermore, Park’s serial number and secrete (sic) number do not meet the claim’s “wallet number” at least because Park is silent to its serial and secrete numbers being generated in response to creating an electronic wallet. Park teaches its serial and secrete numbers are merely associated with Park’s prepaid card (Park [0035]-[0036]), yet Park is silent to generating its serial and secrete numbers associated with its electronic wallet and is silent to the generation of its serial and secrete numbers.

Also, the claim’s “wallet number” is outside the scope of Armes at least because Armes is silent to a “wallet number,” as set forth in the claim. While Armes’s system generates a secondary transaction number (Armes [0014]), Armes is silent to its secondary transaction number being generated and associated with an electronic wallet and Armes is silent to its secondary transaction number being generated and associated in response to the creation of an “electronic wallet,” as set forth in the claim. Hence, the claim’s limitations of “responsive to the user creating the electronic wallet, the centralized personal data base generating a wallet number associated with the electronic wallet” are outside the scope of the combination of cited art.

Thus, the claim comprises features and limitations that are outside the scope of the combination of cited art. Therefore, Appellant respectfully requests that the rejection be reversed.

B. GROUND OF REJECTION 2 (Claim 17)

Claim 17 was rejected under 35 U.S.C. 103(a) over U.S. Patent Application Publication No. 2001/0034720 (herein Armes) in view of U.S. Patent No. 6,607,530 (herein Shub). Final Office Action pp. 2-4.

1. *Claim 17*

Claim 17 recites “responsive to the user creating the electronic wallet, the centralized personal data base generating a wallet number associated with the electronic wallet,” “making a purchase … by sending … the wallet number to the merchant,” “the merchant sending … the wallet number to the centralized personal data base.” The Examiner alleges Armes teaches these limitations citing to Armes [0022]-[0023]. Final Office Action p.3.

The claim's "wallet number" is outside the scope of Armes at least because Armes is silent to a "wallet number," as set forth in the claim. While Armes's system generates a secondary transaction number (Armes [0014]), Armes is silent to its secondary transaction number being generated and associated with an electronic wallet and Armes is silent to its secondary transaction number being generated and associated in response to the creation of an "electronic wallet," as set forth in the claim.

Also the claim's "wallet number" is outside the scope of Shub at least because Shub is silent to a "wallet number," as set forth in the claim. While Shub teaches a transaction private number (Shub 3:40-55), Shub is silent to its transaction private number being generated and associated with an electronic wallet and Shub is silent to its secondary transaction number being generated and associated in response to the creation of an "electronic wallet," as set forth in the claim. Hence, the claim's limitations of "responsive to the user creating the electronic wallet, the centralized personal data base generating a wallet number associated with the electronic wallet," "making a purchase ... by sending ... the wallet number to the merchant," "the merchant sending ... the wallet number to the centralized personal data base" are outside the scope of the combination of cited art.

Furthermore, the proposed combination would render Shub's invention unsuitable for its intended purpose. If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Shub states the intended purpose for its invention is that, except for the customer, no party ever possesses all the information necessary to link the customer to the merchant. Shub 3:56-67. Shub also teaches its payment agency 102 generates the transaction private number (3:40-55) and that Shub's transaction private number is communicated by Shub's merchant to clearing house 104 (4:40-42). But Shub's transaction private number is not communicated by Shub's merchant to payment agency 102 because doing so would give payment agency 102 all the information necessary to link Shub's customer to Shub's merchant. Specifically, by receiving the transaction private number from the merchant, Shub's payment agency 102 would know both the customer and the merchant involved in the transaction since the payment agency 102 generated the transaction private number for the customer and received the transaction private number from the merchant. As such, the modification would allow Shub's payment agency 102

to link the customer to the merchant, contrary to Shub's intended purpose (*see* Shub 3:56-67) and render Shub's invention unsuitable for its intended purpose.

Thus, the claim comprises features and limitations that are outside the scope of the combination of cited art and the proposed combination would render the art unsuitable for its intended purpose. Therefore, Appellant respectfully requests that the rejection be reversed.

C. CONCLUSION

As shown above, the Examiner has failed to state valid rejections against any of the claims. Therefore, Appellant requests that the Board of Patent Appeals and Interferences reverse the rejections. Additionally, Appellant requests that the Board direct the examiner to allow the claims.

Date: September 5, 2008

Respectfully submitted,

/Rudolf O. Siegesmund/

Rudolf O. Siegesmund

Reg. No. 37,720
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Appellant

CLAIMS APPENDIX

The text of the claims involved in the appeal is as follows:

17. A method of completing a financial transaction between a user having a payment account and a merchant having a merchant account, the method comprising:
 - a) the user logging on to a centralized personal data base using a basic number and a primary number, wherein the basic number is accessible by the user but not by the merchant;
 - b) the user creating an electronic wallet in the centralized personal data base by inputting a payment account number of the user's payment account to associate with the electronic wallet, a payment limit of the electronic wallet, and an expiration date of the electronic wallet;
 - c) responsive to the user creating the electronic wallet, the centralized personal data base generating a wallet number associated with the electronic wallet;
 - d) the user making a purchase from the merchant on a purchase date by sending the primary number and the wallet number to the merchant, wherein the purchase has a price;
 - e) the merchant sending the primary number and the wallet number to the centralized personal data base; and
 - f) the centralized personal data base determining whether the purchase is authorized by determining whether the purchase price exceeds the payment limit of the electronic wallet and whether the purchase date is after the expiration date, wherein the purchase is authorized when the purchase price does not exceed the payment limit and the purchase date is not after the expiration date;

g) responsive to determining that the purchase is authorized, the centralized personal data base debiting the user's payment account for the purchase price and crediting the merchant account.

EVIDENCE APPENDIX

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the Examiner is being submitted.

RELATED PROCEEDINGS APPENDIX

This appeal has no related proceedings.